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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,347	01/19/2001	Raghavan Rajagopalan	MRD-60	7678

26875 7590 12/24/2003
WOOD, HERRON & EVANS, LLP
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CINCINNATI, OH 45202

EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 12/24/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,347

Applicant(s)

RAJAGOPALAN ET AL.

Examiner

Mary (Molly) E. Ceperley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 2-7 and 9-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1) Newly submitted claim 28 is directed to an invention that is independent or distinct from the invention originally elected for the following reasons: The compound of claim 6 wherein "Ar" is defined as "heteroaromatic phenanthrene" (exact meaning unclear) is not encompassed by the elected compounds wherein "Ar" is defined as "phenanthridine". See paragraph **5)** of the February 03, 2003 Office action. Note that a "phenanthridine" moiety is a tricyclic hetero ring system wherein the central ring contains a nitrogen atom whereas a "phenanthrene" moiety is a tricyclic carbocyclic ring system.

Since applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 28 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3) Claims 1 and 8 are again rejected under judicially created doctrine as being drawn to an improper Markush group for the reasons stated in paragraph **3)** of the June 04, 2003 Office action. Applicants did not address this rejection in their response of September 05, 2003.

4) Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **a)** Molecular Diagnostics (EP 187,332) taken in combination with **b)** the admitted prior art for the reasons set forth in paragraph **12)** of the June 04, 2003 Office action.

Applicants' arguments filed September 05, 2003 have been fully considered but they are not persuasive. Applicants' argument is directed to the use of the claimed conjugate which is composed of a photosensitive azidophenanthridine compound in combination with a somatostatin receptor binding molecule. However, what is being claimed is the product *per se*. Molecular Diagnostics clearly describes the conjugation of an azidophenanthridine compound to, for example, biotin (page 26, MD 223) and a

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wide variety of other types of ligand known to be useful in specific binding reactions (page 14, line 19 – page 15, line 24). This description clearly generically suggests azidophenanthridine/ligand conjugates are useful for labeling nucleic acids while the admitted prior art establishes that somatostatin-somatostatin receptor binding molecule is a well known ligand-receptor combination. One skilled in the art would expect that a conjugate of azidophenanthridine with any well known ligand would be useful as a labeling agent for nucleic acids as described by Molecular Diagnostics. Criticality has not been established for the choice of one of a well known set of ligand-receptor binding pairs. Consistent with the statement made by applicants in the paragraph bridging pages 19 and 20 of the September 05, 2003 response establishing what the term "somatostatin receptor binding molecule" means to one skilled in the art, it is presumed that applicants do not contest the fact that that somatostatin/somatostatin receptor binding molecule is a well known ligand/receptor binding pair.

5) THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

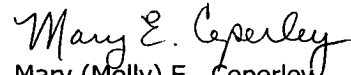
6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (703) 308-4239. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556 or (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

December 20, 2003


Mary (Molly) E. Ceperley
Primary Examiner
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